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plate further includes a tool support means for supporting tools comprising various sized orifices formed by said lateral support plate.

9. The vehicle lift rack mounted tool organizer of Claim 6, wherein said lateral support plate further includes a beverage receptacle support means for supporting a beverage.

#### REMARKS

Reconsideration of the application as amended is respectfully requested.

The examiner respectfully rejected Claims 1-10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The specification as well as Claims 1-3, 5, 7, 8, and 9 have been amended so as to overcome the aforementioned rejection under 35 U.S.C. 112, second paragraph.

The examiner respectfully rejected Claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Chen.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Many differences exist between the invention claimed in Chen and the currently claimed invention. To briefly summarize the distinguishing features and characteristics between the two, Chen teaches a tool box having a drawer member to receive additional tools and other miscellaneous items.

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However, Chen fails to teach laterally-adjustable support means connected to the storage volume for grasping a rack arm of a conventional vehicle lift rack.

In addition, Chen fails to teach a pneumatic driving tool support means, a cup support means for supporting cups, and a rag support means for supporting rags.

Therefore, in light of the numerous differences between Chen and the present invention, the examiner's rejection of Claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Chen is inappropriate.

The examiner respectfully rejected Claim 3 under 35 U.S.C. 102(b) as being anticipated by Perkins. Perkins teaches a tool box for small hand tools and associated items which has a pivoting front cover and top cover.

However, like Chen, Perkins fails to teach a laterally-adjustable support means connected to the storage volume for grasping a rack arm of a conventional vehicle lift rack.

The examiner argues the device taught by Perkins comprises a support means "36". However, element "36" as taught by Perkins is a *carrying handle* and not a *support means* as

described by the present invention.

Therefore, the examiner's rejection of Claim 3 under 35 U.S.C. 102(b) as being anticipated by Perkins is inappropriate.

The examiner respectfully rejected Claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over Perkins in view of Bishop. The differences with respect to Perkins have been stated above.

Bishop teaches a tool storage and transport system for keeping and transporting tools and equipment.

Admittedly, Bishop discloses box hangers and bin hangers. However, unlike the present invention, Bishop fails to teach a pair of *laterally-adjustable* support hooks connected to the storage volume for grasping a rack arm of a conventional vehicle lift rack. In contrast, Bishop teaches that the "box hangers 37 and bin hangers 41 are fixedly attached to the box 30 and bins 40 . . ." Col. 4, lines 15-16.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the

proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of the combination of features of the vehicle lift rack mounted tool organizer. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853

F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,



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## **VERSION WITH MARKINGS TO SHOW CHANGES MADE**

### **In the Specification**

On page 6, line 5, after the word "include" insert --a pneumatic driving tool support--.

On page 6, line 5, after the word "means" insert --30--.

On page 6, line 6, delete "30," and replace with --,a tool supporting--.

On page 6, line 6, delete "33".

On page 6, line 7, after the phrase "as well as" insert --a cup support--.

On page 6, line 7, after the word "means" insert --34--.

On page 6, line 8, delete "34, rags 36," and replace with --, a rag support means 36 for supporting rags,--.

### **In the Claims**

Please amend the following claims by deleting the language which is enclosed in brackets "[ ]" and inserting the language which is underlined " \_\_\_\_\_".

1.(Once Amended) A vehicle lift rack mounted tool organizer adapted for use with a conventional vehicle lift rack of a type having rack arms, said organizer comprising:

a storage volume, said storage volume formed by a bottom connected to a plurality of vertical sidewalls and having an articulated lid,

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support means connected to said storage volume for grasping [said] the rack arm in a manner that allows [the] said organizer to be supported through gravity impingement extending cantilever outward from [the] said support means in a manner that hangs below [the] a horizontal level of the rack arm;

a pneumatic driving tool support means for supporting pneumatic driving tools;

a tool support means for supporting tools formed by a lateral support plate;

a cup support means for supporting cups; and

a rag support means for supporting rags.

2.(Once Amended) The vehicle lift rack mounted tool organizer of Claim 1, further comprising  
a slidably retained storage drawer provided along [the] a lower surface of [the] said organizer, thereby allowing for additional storage.

3.(Once Amended) A vehicle lift rack mounted tool organizer comprising:

a support means for mounting to support arms of an otherwise conventional vehicle lift rack; and

a main containment volume formed in a boxlike fashion extending cantilever outward from said support means in a manner that hangs below the horizontal level of [said] the rack arm ;

a hinged, lockable lid affixed to and covering said main containment volume.

5.(Once Amended) The vehicle lift rack mounted tool organizer of Claim 4, wherein said pair of support hooks are laterally adjustable in size, from between 3 inches to 5-1/2 inches in order to accommodate various standard makes of lift racks currently commercially available.

7.(Once Amended) The vehicle lift rack mounted tool organizer of Claim 6, wherein said lateral support plate further [include] includes a pneumatic driving tool support means for supporting pneumatic driving tools.

8.(Once Amended) The vehicle lift rack mounted tool organizer of Claim 6, wherein said lateral support plate further [include] includes a tool support means for supporting tools comprising various sized orifices formed by said lateral support plate.

9.(Once Amended) The vehicle lift rack mounted tool organizer of Claim 6, wherein said lateral support plate further [include] includes a beverage receptacle support means for supporting a beverage [receptacle].